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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/538,583

Filing Date: June 15, 2005

Appellant(s): STIEGER ET AL.

Robert M. Barrett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April, 8, 2010 appealing from the Office action mailed November 16, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1 and 3-12

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,499,389	Probst	12-2002
5,768,987	Cicchetti	6-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,499,389 to Probst in view of U.S. Patent No. 5,768,981 to Cicchetti

As per claim 1, Probst teaches nozzle that can be fitted onto a steam outlet of a coffee machine intended to froth a liquid (Abstract, Probst), the nozzle comprising a mouth (3) for receiving the steam, a restriction (3a) in a continuation of the mouth, and a flared zone (13) along the axis of the restriction and of the mouth to allow the liquid out, having a cross section approximately equal to the cross section of the mouth (See Figure 1), and approximately perpendicular to the mouth, an inlet pipe (starting from (6), including (20) and (8) and the extension of nozzle body (2)) for allowing in liquid and an air inlet intake (air conduit (8)) formed directly on the inlet pipe as a hole, a slit or a pipe which opens into the inlet pipe (8), wherein the nozzle is disposable and configured in

one piece formed from an assembly of two injection-molded welded plastic shells that are compatible with food use.

Probst does not show the nozzle being made of one piece, nor the material it is made of, however, Cicchetti teaches a mostly-one piece (25) housing of a mouth (15), outlet (20) and perpendicular milk inlet (17).

Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Probst with a unitary housing as suggested by Cicchetti. Using the construction of Cicchetti as a modifier for Probst would provide a unitary construction capable of being disposable.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have proclaimed a compatible material for the nozzle, (i.e. food grade plastic, e.g. propylene), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and engineering logic.

Additionally, as Probst and Cicchetti do not teach a disposable nozzle piece per se, doing so is known to be making a piece removable and therefor portable, and it has been held that making an old device portable or movable without producing any new and expected results involves only routine skill in the art and engineering logic.

Lastly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the nozzle of two shells, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art and engineering logic.

As per claim 3, the air inlet of Probst, opens at a right angle to the inlet pipe, continues parallel to the inlet pipe and then opens to the inlet pipe parallel to the pipe at the pipe's interior, chamber (7).

As per claim 4, Probst depicts a pipe (combined as the extension of the nozzle body (2) allowing a tube ((21), as part of flow limiting element (5)) to be fitted for drawing up liquid.

As per claim 5, the flared zone (13) of Probst is taught to be an emulsifying chamber (9) which by definition would break a jet.

As per claim 6, as best as can be determined, a blind ring (17) and settling segment (16) cooperate to create a stabilizing zone at the outlet of Probst.

As per claim 7, neither Probst nor Cicchetti teach a specific material for the nozzle, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to have chosen a desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and engineering logic.

As per claim 8, neither Probst nor Cicchetti teach specific sizes for any one piece of the nozzle assembly, however, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize 1-3 mm for the air inlet (at (8), and 10 to 15 mm for the mouth (3) since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform

differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As per claim 9, neither Probst nor Cicchetti teach specific sizes for any one piece of the nozzle assembly, however, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize 2 to 4mm as the diameter for the restriction zone (3a) of Probst since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As per claim 10, neither Probst nor Cicchetti teach specific sizes for any one piece of the nozzle assembly, however, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize 4 to 20mm as the height for the stabilization zone ((16) and (17)) of Probst since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As per claim 11, Probst teaches a nozzle (2, 1) that can be fitted onto the steam outlet (4) of a coffee machine intended to froth a liquid, the nozzle having a mouth (at (3)) for receiving and letting in steam, a restriction (3a) in the mouth , and a flared zone (13) along the axis of the said restriction and of the mouth having a cross section more

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or less approximately equal to the cross section of the mouth (See Figure 1), and extending at an angle from the mouth a pipe (starting from (6), including (20) and (8) and the extension of nozzle body (2)) perpendicular to the mouth for allowing in liquid, and an air inlet (8), the air inlet. Probst does not show the nozzle being made of one piece, nor the material it is made of, however, Cicchetti teaches a mostly-one piece (25) housing of a mouth (15), outlet (20) and perpendicular milk inlet (17).

Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Probst with a unitary housing as suggested by Cicchetti. Using the construction of Cicchetti as a modifier for Probst would provide a unitary construction capable of being disposable.

Additionally, as Probst and Cicchetti do not teach a disposable nozzle piece per se, doing so is known to be making a piece removable and therefor portable, and it has been held that making an old device portable or movable without producing any new and expected results involves only routine skill in the art and engineering logic.

Lastly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the nozzle of two shells, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art and engineering logic.

As per claim 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have proclaimed a compatible material for the nozzle, since it has been held to be within the general skill of a worker in the art to select a known material (i.e. food grade plastic, e.g. propylene), on the basis of its

suitability for the intended use as a matter of obvious design choice and engineering logic.

(10) Response to Argument

As per the arguments beginning on page 11, paragraph 3, it has been upheld in the courts that forming what was previously a multitude of components into an integral one-piece structure is an extension of engineering logic and obvious to one having ordinary skill in the art. Further, the use of the modifying art of Cicchetti in order to teach unitary construction in the nozzle assembly of Probst is valid in that, the nozzle (or duct (27), as argued) is of one piece, and fits over another piece (dispenser (27)). The notation of the Examiner's use of the term "mostly" one-piece is used to show that where Probst teaches a multitude of parts for its "nozzle arrangement" ((1),(2)), Cicchetti teaches a fewer number of parts to accomplish the same if not similar arrangement. Furthermore, as the prior art teachings of Cicchetti address the problem of cleaning parts that may become contaminated, it can only be of an extension of reasonable logic to extend this thinking to a one-piece disposable nozzle, as claimed.

As per the argument of the use of plastics, page 13, paragraph 2, it should be stated that sanitation rules such as NSF Standards 2, 8, and 18 exist for the purpose of declaring approved materials for use in commercial food and beverage equipment. As such, it would have to be in the Applicant's best interest to include approved materials (food grade propylene) for the construction of devices falling within the criterion set forth by published standards. And as 35 U.S.C. 103(a) fully addresses the design intention to combine many pieces into a single piece (i.e. to make integral) any further process to

make a piece disposable is an extension of common sense, as just about every manufactured good has a lifespan that requires eventual disposal or recycling.

Therefore, the instance that the nozzle be disposable and the use of plastics that are compatible to food use are known strategies for qualifying an apparatus for sanitation qualifications and therefore are not qualifying for a patented claim.

As for the argument that there would be no reason to combine Probst and Cicchetti page 14, paragraph 1, the Examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the various components that make up the assemblies of the prior arts are well known in their functionality for their intended use (i.e. for coffee dispensing), and as such applying the logic of integral construction to those arts as argued qualifies as knowledge generally available.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 14, paragraph 3), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/James S Hogan/

Examiner, Art Unit 3752

Conferees:

/Len Tran/

Supervisory Patent Examiner, Art Unit 3752

Conferees:

/Michael Phillips/

RQAS